



FEB 19 2002

In re

:  
: DECISION ON  
: PETITION FOR REGRADE  
: UNDER 37 C.F.R. § 10.7(c)  
:

**MEMORANDUM AND ORDER**

petitions for regrading his-her answers to questions 9, 35, 37, 43, and 50 of the morning section and questions 7 and 36 of the afternoon section of the Registration Examination held on April 18, 2001. The petition is denied to the extent petitioner seeks a passing grade on the Registration Examination.

**BACKGROUND**

An applicant for registration to practice before the United States Patent and Trademark Office (USPTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sections of the Registration Examination. Petitioner scored 65. On July 31, 2001, petitioner requested regrading, arguing that the model answers were incorrect.

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, a single final agency decision will be made regarding each request for regrade. The decision will be reviewable under

35 U.S.C. § 32. The Director of the USPTO, pursuant to 35 U.S.C. § 2(b)(2)(D) and 37 CFR 10.2 and 10.7, has delegated the authority to decide requests for regrade to the Director of Patent Legal Administration.

### **OPINION**

Under 37 C.F.R. § 10.7(c), petitioner must establish any errors that occurred in the grading of the Examination. The directions state: " No points will be awarded for incorrect answers or unanswered questions." The burden is on petitioners to show that their chosen answers are the most correct answers.

The directions to the morning and afternoon sections state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a court decision, a notice in the Official Gazette, or a notice in the Federal Register. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct answer is the answer that refers to each and every one of the correct choices. Where a

question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement true. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms "USPTO" or "Office" are used in this examination, they mean the United States Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers. All of petitioner's arguments have been fully considered. Each question in the Examination is worth one point.

Petitioner has been awarded an additional one point for afternoon question 36. Accordingly, petitioner has been granted an additional one point on the Examination. No credit has been awarded for morning questions 9, 35, 37, 43, and 50 and afternoon question 7. Petitioner's arguments for these questions are addressed individually below.

Morning question 9 reads as follows:

9. Which of the following is not in accord with proper USPTO practice and procedure?

(A) A written description as filed in a nonprovisional patent application is presumed adequate under 35 U.S.C. § 112 in the absence of evidence or reasoning to the contrary.

(B) An examiner may show that a written description as filed in a nonprovisional patent application is not adequate by presenting a preponderance of evidence why a person of ordinary skill in the art would not recognize in the applicant's disclosure a description of the invention defined by the claims.

(C) A general allegation of "unpredictability in the art" is sufficient to support a rejection of a claim for lack of an adequate written description.

(D) When filing an amendment, a practitioner should show support in the original disclosure for new or amended claims.

(E) When there is substantial variation within a genus, an applicant must describe a sufficient variety of species to reflect the variation within the genus.

The model answer is selection (C).

Selection (C), not being in accord with proper USPTO practice and procedure, is the most correct answer. As stated in "Guidelines for Examination of Patent Applications under 35 U.S.C. 112, ¶ 1, 'Written Description' Requirement," 66 F.R. 1099, 1107 (Jan. 5, 2001), middle column, "A general allegation of 'unpredictability in the art' is not a sufficient reason to support a rejection for lack of adequate written description." (A), being in accord with proper USPTO practice and procedure, is not correct. As stated in "Guidelines for Examination of Patent Applications under 35 U.S.C. 112, ¶ 1, 'Written Description' Requirement," 66 F.R. 1099, 1107 (Jan. 5, 2001), left column, "A description as filed is presumed to be adequate..." (B), being in accord with proper USPTO practice and procedure, is not correct. As stated in "Guidelines for Examination of Patent Applications under 35 U.S.C. 112, ¶ 1, 'Written Description' Requirement," 66 F.R. 1099, 1107 (Jan. 5, 2001), "A description as filed is presumed to be adequate, unless or until sufficient evidence or reasoning to the contrary has been presented by the examiner to rebut the presumption.<sup>65</sup> ... The examiner has the initial burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims.<sup>66</sup> " (footnotes not reproduced). (D), being in accord with proper USPTO practice and procedure, is not correct. As stated in "Guidelines for Examination of Patent Applications under 35 U.S.C. 112, ¶ 1, 'Written Description' Requirement," 66 F.R. 1099, 1107 (Jan. 5, 2001), left column, "[W]hen filing an amendment, applicant should show support in the original

disclosure for new or amended claims.<sup>59</sup> Footnote 59 states, "See MPEP §§ 714.02 and 2163.06 ('Applicant should... specifically point out the support for any amendments made to the disclosure.')." (E), being in accord with proper USPTO practice and procedure, is not correct. As stated in "Guidelines for Examination of Patent Applications under 35 U.S.C. 112, ¶ 1, 'Written Description' Requirement," 66 F.R. 1099, 1106 (Jan. 5, 2001), right column, "[W]hen there is substantial variation within a genus, an applicant must describe a sufficient variety of species to reflect the variation within the genus."

Petitioner argues that answer (B) is not in accord with proper USPTO practice and procedure, and is thus a correct answer in terms of the question posed. According to petitioner, the opening phrase "An examiner may show..." places answer (B) at odds with proper USPTO practice and procedure, because what follows the opening phrase is not optional. Applicant's arguments have been fully considered but are not persuasive. It is not true that an examiner must make the showing described in answer (B), because that showing can only be made if an application lacks an adequate written description of the claimed invention. Contrary to petitioner's arguments, answer (B) is in accord with proper USPTO practice and procedure, and is thus an incorrect answer in terms of the question posed. Accordingly, model answer (C) is correct and petitioner's answer (B) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 35 reads as follows:

34 – 36. The following facts apply to the following three questions. For purposes of these questions, it should be assumed that the statutes and regulations effective as of April 18, 2001 apply for all time periods covered by the questions. Joseph, a citizen and resident of the United States, invented a new brake for in-line skates and filed a nonprovisional utility patent application in the USPTO on February 8, 2001. The application as filed included a specification and claims in compliance with 35 USC § 112, three sheets of publication quality drawings, an abstract of the disclosure, and an information sheet listing the name and address of the inventor. The application was initially filed without an executed inventor's oath or declaration and without the required filing fee. The Office issued a "Notice to File Missing Parts – Filing Date Granted" on April 2, 2001. The Notice informed Joseph that he must submit an executed oath or declaration by the inventor, pay the required filing fee, and pay a surcharge for late submission of these items within two (2) months of the date of the Notice. Joseph received the Notice on April 9, 2001. Joseph brought the Notice with him when he left for an extended overseas business trip the next day, April 10, 2001. Unfortunately, the Notice was placed in luggage that was lost during the trip. Upon his return to the United States on July 26,

2001, Joseph obtained a copy of the Notice and, on August 2, 2001 filed a Reply in full compliance with the Notice. A Petition for a two-month extension of time and all required fees accompanied the Reply. Joseph also requested waiver and a refund of fees associated with the Petition for extension of time on the basis that the delay was a result of his lost luggage and his extended trip overseas. In Joseph's view, even though he could have replied within the two-month period, it was unfair to penalize him for lost luggage. The request for waiver of fees was denied. A first substantive Office action on the merits of the application issued December 19, 2001 and set a three-month shortened statutory time for reply. All pending claims were rejected on the basis of prior art. Joseph filed a fully responsive Amendment on March 19, 2002, and a final Office action issued August 12, 2002 with a three-month shortened statutory period for reply. The final Office Action allowed certain claims and rejected other claims on substantially the same grounds set forth in the first Office action. Joseph filed a Notice of Appeal on September 19, 2002 and an Appeal Brief on March 18, 2003. A Petition for extension of time and proper authorization to charge a deposit account for any required fees accompanied the Appeal Brief. An Examiner's Answer issued on April 2, 2003, and Joseph filed a Reply Brief on April 15, 2003. The Board of Patent Appeals and Interferences reversed the Examiner's rejections on August 19, 2003. A Notice of Allowance and Issue Fee Due was mailed September 3, 2003. Joseph paid the Issue Fee on September 15, 2003 and the patent issued March 9, 2004.

35. In addition to the facts set forth in connection with the previous question, Joseph's application had not and would not be the subject of an application filed in another country, or under a multilateral international agreement, that requires publication of applications eighteen months after filing. At the time he filed his application in the USPTO, Joseph submitted a nonpublication request and supporting materials that fully complied with all requirements for nonpublication of the application at 18 months. Which of the following statements is most correct?

- (A) By requesting nonpublication of the application, Joseph "opted out" of the statutory framework for patent term extension and, therefore, no patent term extension is available.
- (B) Submission of the nonpublication request does not affect any patent term extension that might be available to Joseph.
- (C) Joseph may rescind his nonpublication request at any time.
- (D) Statements (A) and (C) are true.
- (E) Statements (B) and (C) are true.

The model answer is selection (E).

Nonpublication of the application does not affect the patent term extension provisions of the Patent Term Guarantee Act of 1999. Thus, statement (B) is true. The patent term extension provisions of 37 CFR §§ 1.702 et seq. are separate and independent of the eighteen-month publication provisions. There is no support for statement (A). An applicant may rescind a nonpublication request at any time. See "37 CFR Parts 1 and 5 -- Changes To Implement Eighteen-Month Publication of Patent Applications; Final Rule," Federal Register Vol. 65, No. 183 (9/20/2000) at 57024, middle column. Thus, statement (C) is also true. Accordingly, the best answer is (E).

Petitioner argues that answer (B) is correct. Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's arguments that answer (B) is correct, the paragraph above explains why answer (B) is not the most correct answer. In fact, 37 CFR 1.213(b) prescribes, inter alia, that "[T]he applicant may rescind a nonpublication request at any time." Accordingly, model answer (E) is correct, and petitioner's answer (B) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 37 reads as follows:

37. In which of the following instances is the filing of a request for continued examination (RCE) of an application, together with a submission and payment of the appropriate fee, in accordance with proper USPTO practice and procedure?

(A) The RCE, including an amendment to the written description, is filed on April 17, 2001, in a nonprovisional utility application having a filing date in July 1998. A Notice of Appeal to the Board of Patent Appeals and Interferences had been filed in November 2000, and as of April 17th the appeal is awaiting a decision.

(B) The RCE, including an amendment to the written description, is filed on April 17, 2001, in a nonprovisional utility application having a filing date in July 1996. A Notice of Appeal to the United States Court of Appeals for the Federal Circuit was properly filed in January 2001, and the appeal has not terminated as of April 17th .

(C) The RCE, including an amendment to the written description, is filed on April 17, 2001, in a nonprovisional utility application having a filing date in July 1999. The issue fee was filed in the Office on Friday, January 19, 2001, but a petition and fee to withdraw the application has not been filed.

(D) The RCE, including an amendment to the written description, is filed on April 17, 2001, for a nonprovisional utility application having a filing date in July 1996. On Monday, April 2, 2001, Applicant withdrew a Notice of Appeal to the United States Court of Appeals for the Federal Circuit. There were no allowed claims in the application, and the Court's dismissal of the appeal did not indicate any further action to be taken by the Office.

(E) The RCE, including an amendment to the written description, is filed on April 17, 2001, for a provisional utility application having a filing date in July 2000.

The model answer is selection (A).

37 C.F.R. § 1.114(a) and (d). The filing of a request for continued examination, including a submission, after the filing of a Notice of Appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal is considered a request to withdraw the appeal and reopen prosecution of the application before the examiner. The submission may be an amendment to the written description. 37 C.F.R. § 1.114(c). See, "Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule," 65 F.R. 50092, 50095, left column, third complete paragraph (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). (B) is not the most correct answer. 37 C.F.R. § 1.114(a)(3). The procedure of § 1.114 is not available in an application after the filing of a Notice of Appeal to the Federal Circuit unless the appeal is terminated and the application is still pending. See, "Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule," 65 F.R. 50092, 50095, middle column, first complete paragraph (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). (C) is not the most correct answer. The filing of an RCE (with a submission and fee) in an allowed application after the issue fee has been paid without a petition under 37 C.F.R. § 1.313 to withdraw the application from issue "will not operate to avoid issuance of the application as a patent." See, "Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule," 65 F.R. 50092, 50095, middle column, second complete paragraph (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). (D) is not the most correct answer. The procedure of § 1.114 is not available in an application after the filing of a Notice of Appeal to the Federal Circuit unless the appeal is terminated and the application is still pending. See, MPEP 1216.01; and "Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule," 65 F.R. 50092, 50095, middle column, first complete paragraph (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). (E) is not the most correct answer. 37 C.F.R. § 1.114(e)(1). "The continued examination provisions of 35 U.S.C. 132(b) and §1.114...will not be available for: (1) A provisional application (which is not examined under 35 U.S.C. chapter 12)." See, "Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule," 65 F.R. 50092, 50095, left column, second complete paragraph (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000).

Petitioner argues that “answer (A) should be accepted equally as correct as answer (D).” However, answer (A) is accepted as correct as it is the model answer. Further, for the reasons stated above, answer (D) is incorrect. Petitioner’s arguments have been fully considered but are not persuasive. Accordingly, model answer (A) is correct, and petitioner’s answer (D) is incorrect.

Morning question 43 reads as follows:

43. As a new member of a law firm, you are assigned to continue the prosecution of a patent application that was prosecuted by Stewart, who recently joined another law firm. After reviewing the file, you note that Stewart's reply to a first Office included two amendments: Amendment #1 introduced a change to the specification which did not affect the claims; Amendment #2 introduced a change to the specification, which change was also introduced to all of the claims currently in the application. You also note that the examiner in a current Office action has taken the position that both amendments constituted new matter, required cancellation of the new matter, and rejected all the claims on the ground that they recited elements without support in the original disclosure under 35 U.S.C. 112, first paragraph. For the purpose of reviewing the examiner's requirement, which of the following statements accords with proper USPTO practice and procedure?

- (A) Both Amendment #1 and Amendment #2 give rise to appealable questions.
- (B) Review of the examiner's requirement for cancellation of both Amendment #1 and Amendment #2 is by way of petition.
- (C) Review of the examiner's requirement for cancellation of Amendment #1 is by way of petition, and review of the examiner's requirement for cancellation of Amendment #2 is by way of appeal.
- (D) Review of the examiner's requirement for cancellation of Amendment #1 is by way of appeal, and review of the examiner's requirement for cancellation of Amendment #2 is by way of petition.
- (E) Both Amendment #1 and Amendment #2 give rise to questions which may be reviewed either by petition or on appeal.

The model answer is selection (C).

MPEP § 608.04(c) includes the following recitation: Where the new matter is confined to amendments to the specification, review of the examiner's requirement for cancellation is by way of petition. But where the alleged new matter is introduced into or

affects the claims, thus necessitating their rejection on this ground, the question becomes an appealable one. See, also, MPEP § 706.03(o), which includes the following recitation: In amended cases, subject matter not disclosed in the original application is sometimes added and a claim directed thereto. Such a claim is rejected on the ground that it recites elements without support in the original disclosure under 35 U.S.C. 112, first paragraph. [Note re Question 43, third line of factual background : Examination proctors were instructed to direct examination candidates to delete from the third line of the factual background the word -- in--. The question has been carefully reviewed to see if there is any alternative reasonable meaning to the question if the change was not made. No such meaning was found. The Director of Enrollment and Discipline concluded that omission of the change should have no material affect on the question, and should not inhibit an individual's ability to correctly answer the question.]

Petitioner argues that answer (B) is correct. Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's arguments that answer (B) is correct, the paragraph above explains why answer (B) is incorrect. The question set forth that the change introduced to the specification by Amendment #2 "was also introduced to all of the claims currently in the application." The examiner's new matter rejection of the claims based on that change is an appealable matter. Accordingly, model answer (C) is correct, and petitioner's answer (B) is incorrect.

Morning question 50 reads as follows:

50. An article in a popular scientific journal, dated January 13, 2000, fully discloses and teaches how to make a "Smart Shoe" wireless telecommunications device. The article discloses a shoe having a dialer in a rubber sole of the shoe. The article does not teach a metallic shoelace or suggest using the same as an antenna or for any other purpose. Which of the following claims in an application filed January 22, 2001 is/are anticipated by the journal article, and is/are not likely to be properly rejected under 35 U.S.C. § 112, second paragraph as indefinite?

Claim 1. A telecommunication device comprising: a shoe having a rubber sole; a dialer in the rubber sole; and a metallic shoelace.

Claim 2. A telecommunications device comprising: a shoe having a rubber sole; a dialer in the rubber sole; and optionally a metallic shoelace.

Claim 3. A telecommunication device comprising: a shoe having a rubber sole; a dialer in the rubber sole; and optionally a random access memory for storing telephone numbers.

(A) Claim 1.

- (B) Claim 2.
- (C) Claim 3.
- (D) Claims 2 and 3.
- (E) None of the above.

The model answer is selection (D).

MPEP § 2173.05(h), and *Ex Parte Cordova*, 10 USPQ2d 1949 (Bd. Pat. App. & Inter. 1989) and 35 U.S.C. § 102(b). (A) is incorrect since the article does not disclose a metallic shoelace, whereas Claim 1 requires a telecommunications device having a metallic shoelace. Since the "optional" element does not have to be disclosed in a reference for the claim to be anticipated, claims 2 and 3, which provide for inclusion of optional elements, are each anticipated by the article. Thus, (B), and (C), are incorrect. Inasmuch as (C) is correct, (E) is incorrect.

Petitioner argues that answer (A) is correct. Petitioner's arguments have been fully considered but are not persuasive. A fact set forth in the question is that "[T]he article does not teach a metallic shoelace or suggest using the same as an antenna or for any other purpose." Claim 1, which recites a "metallic shoelace" is therefore not anticipated by the article. Accordingly, model answer (D) is correct, and petitioner's answer (A) is incorrect.

Afternoon question 7 reads as follows:

7. Which of the following is not in accordance with proper USPTO practice and procedure regarding design patent applications filed in March 2001?

(A) The elements of the design application, if applicable, should appear in the following order:

- (1) design application transmittal form;
- (2) fee transmittal form;
- (3) application data sheet;
- (4) specification;
- (5) drawings or photographs; and
- (6) executed oath or declaration.

(B) The specification should include the following sections in order:

- (1) preamble, stating the name of the applicant, title of the design, and a brief

description of the nature and intended use of the article in which the design is embodied;  
(2) cross-reference to related applications (unless included in the application data sheet);

- (3) statement regarding federally sponsored research or development;
- (4) description of the figure or figures of the drawing;
- (5) feature description; and
- (6) a single claim.

(C) The text of the specification sections, if applicable, should be preceded by a section heading in uppercase letters without underlining or bold type.

(D) The elements of the design application, if applicable, should appear in the following order:

- (1) design application transmittal form;
- (2) fee transmittal form;
- (3) photographs;
- (4) application data sheet;
- (5) specification;
- (6) drawings; and
- (7) executed oath or declaration.

(E) None of the above.

The model answer is selection (D).

Photographs and ink drawings may not appear in the same application. See § 1.152 Design drawings. Moreover, the order is not that appearing in 37 CFR § 1.154. As to (A), (A) contains the elements set forth in 37 CFR § 1.154 (a), which provides "(a) The elements of the design application, if applicable, should appear in the following order: (1) Design application transmittal form. (2) Fee transmittal form. (3) Application data sheet (see § 1.76). (4) Specification. (5) Drawings or photographs. (6) Executed oath or declaration (see § 1.153(b))." As to (B), (B) contains the elements set forth in 37 CFR § 1.154 (b), which provides: "(b) The specification should include the following sections in order: (1) Preamble, stating the name of the applicant, title of the design, and a brief description of the nature and intended use of the article in which the design is embodied. (2) Cross-reference to related applications (unless included in the application data sheet). (3) Statement regarding federally sponsored research or development. (4) Description of the figure or figures of the drawing. (5) Feature description. (6) A single claim." As to (C), (C) contains the elements set forth in 37 CFR § 1.154 (c), which provides "(c) The text of the specification sections defined in paragraph (b) of this section, if applicable, should be preceded by a section heading in uppercase letters without underlining or bold

type." Since (D) is incorrect, (E) is not the right answer.

Petitioner argues that answer (E) is correct. Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's arguments that answer (E) is correct, the paragraph above explains why answer (E) is incorrect. Accordingly, model answer (D) is correct, and petitioner's answer (E) is incorrect.

Afternoon question 36 reads as follows:

36. A member of the public submits a protest under 37 CFR § 1.291 relating to a public sale of the subject matter of a patent application (effective filing date June 1, 1999). The protest includes submission of a business circular authored by the assignee of the invention. In a first Office action dated January 10, 2001, the examiner includes a requirement for information requesting the date of publication of the business circular. The reply to the requirement for information states that the publication date is "approximately June 1, 2000." Which of the following would be proper for the examiner to include in the next Office action?

- (A) A requirement that the date in the reply be made more specific.
- (B) A holding that the previous reply is incomplete.
- (C) A requirement seeking confirmation that "approximately June 1, 2000" is the most specific date that was obtained or can be obtained based on a reasonable inquiry if that is not already clear from the reply.
- (D) (A) and (C).
- (E) None of the above.

The model answer is selection (C).

37 CFR § 1.105 (effective November 7, 2000); "Changes To Implement the Patent Business Goals; Final Rule," 65 FR 54604, 54634 (September 8, 2000). The example at 65 FR 54634, column 2, states, "The examiner cannot require that the reply be more specific or hold the reply to be incomplete based on such information. The examiner can, however, in the next Office action seek confirmation that this is the most specific date that was obtained or can be obtained based on a reasonable inquiry being made if that is not already clear from the reply." Thus (A) and (B) are incorrect and (C) is correct. (D) is incorrect because (A) is incorrect. (E) is incorrect because (C) is correct.

Petitioner requests credit for this question due to ambiguity in the question itself and the answer choices provided. Petitioner's request for credit on this question is granted.

**ORDER**

For the reasons given above, one point have/has been added to petitioner's score on the Examination. Therefore, petitioner's score is 66. This score is insufficient to pass the Examination.

Upon consideration of the request for regrade to the Director of the USPTO, it is ORDERED that the request for a passing grade on the Examination is denied.

This is a final agency action.

A handwritten signature in black ink, appearing to read 'R. Spar', is positioned above a horizontal line.

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Robert J. Spar  
Director, Office of Patent Legal Administration  
Office of the Deputy Commissioner  
for Patent Examination Policy